

Atty Dkt No. 8325-0011.21 (S11-US3)
USSN: 09/990,186

REMARKS

STATUS OF THE CLAIMS

Claim 1 is pending as amended on February 5, 2002. Applicants gratefully acknowledge withdrawal of the election of species requirement.

INFORMATION DISCLOSURE STATEMENT

Applicants acknowledge with appreciation return of the initialed 1449 forms from the IDS previously submitted. Submitted previously was an Information Disclosure Statement pursuant to 37 C.F.R. § 1.97(c) and accompanying 1449 forms. Applicants request that the Examiner consider the references and return the initialed 1449 forms to the undersigned.

35 U.S.C. § 103

Claim 1 stands rejected as allegedly obvious over U.S. Patent No. 6,453,242 (hereinafter "Eisenberg") in view of U.S. Patent No. 6,140,081 (hereinafter "Barbas") and further in view of U.S. Patent No. 6,503,717 (hereinafter "Case"). Office Action, page 2. Eisenberg is alleged to teach a method of for designing a zinc finger protein with 3 fingers that binds to a preselected target site. Barbas and Case are alleged to teach an F1 finger comprising the sequence QRSNLVR that binds to GAA and F2/F3 fingers comprising the sequence QSGNLAR that bind to GAA, respectively. It is alleged it would have been obvious to combine and substitute the fingers of Barbas and Case into the method of Eisenberg. (Office Action, pages 2-6).

As a threshold matter, Applicant submits that Case and Eisenberg are not properly cited under Section 103(a). As set forth in 35 U.S.C. § 103(c), references which would qualify as prior art under Section 102(e) (Case and Eisenberg), shall not preclude patentability under Section 103 where the subject matter and the claimed invention were, at the time the invention was made, subject to an obligation of assignment to the same entity. Here, Case, Eisenberg and the application at hand were all subject to assignment to Sangamo Biosciences and, as such, neither Case nor Eisenberg are proper 103(a) references. Thus, the obviousness rejection cannot stand and should be withdrawn.

Furthermore, with regard to Barbas, Applicants note that nowhere does this reference teach or suggest methods of designing zinc finger proteins whose constituent zinc fingers bind in a position-dependent manner, as claimed. In other words, Barbas fails entirely to teach or suggest that the location of a zinc finger, within a multi-finger protein, can affect the subsite to which the finger binds.

Thus, because Case and Eisenberg are not properly cited and because there is no teaching or suggestion within Barbas to arrive at the claimed method, withdrawal of the rejection is respectfully requested.

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CONCLUSION

In view of the foregoing remarks, Applicants submit that all pending claims are in condition for allowance and request early notification to that effect. Should the Examiner have any further questions, he is invited to contact the undersigned.

Respectfully submitted,

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By: _____



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